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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,443	07/09/2003	Gregory Wright	V00058.70027US00	9155

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EXAMINER

LEWIS, KIM M

ART UNIT PAPER NUMBER

3743

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/616,443

Applicant(s)

WRIGHT ET AL.

Examiner

Kim M. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-20 is/are allowed.
- 6) ☒ Claim(s) 1,8-13 and 21-25 is/are rejected.
- 7) ☒ Claim(s) 2-7,26 and 27 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/9/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 7/9/03 has been received and made of record in the application file wrapper. Note the acknowledged form PTO-1449 enclosed herewith.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "31" is missing from Fig. 1 as indicated on page 7, line 6. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 8 and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,512,041 ("Bogart").

As regards claim 1, Bogart discloses a wound dressing for promoting moist wound healing which anticipates applicants' claimed invention. More specifically, Bogart discloses a substrate (52) having a perimeter, a first surface and a second surface on an opposite side of the first surface, the second surface of the substrate having a low coefficient of friction; a protective layer (74) disposed on the first surface of the substrate, a layer of a pressure-sensitive adhesive (72) disposed on the first surface of the substrate and surrounding at least a portion of the protective layer, and a sheet of material (60) that is attached to the substrate at attachment locations adjacent the perimeter of the substrate, the sheet of material having a lower surface having a low coefficient of friction, the lower surface of the sheet confronting the second surface of the substrate and being constructed and located to move with respect to the second surface of the substrate in a lower surface having a low coefficient of friction, the lower surface of the sheet confronting the second surface of the substrate and being constructed and located to move with respect to the second surface of the substrate in a direction generally parallel to the substrate (col. 3, lines 40-42, col. 4 lines 30-44 and col. 4, line 50-col. 5, line 2).

As regards claim 8, the attachment locations are continuous around the entire surface of the substrate (col. 4, lines 30-45).

As regards claim 21, Bogart discloses a method for treating a wound comprising applicants' claimed steps of placing a bandage over a wound such that the wound is covered by a protective layer disposed on one side of the bandage; adhesively securing the bandage to the skin using a layer of pressure-sensitive adhesive on the one side of the bandage that surrounds but does not touch the wound; and affixing a sheet of low-friction material adjacent another side of the bandage, the sheet of low-friction material being constructed to be positioned between the bandage and items of clothing, the sheet of low-friction material being movable with respect to the bandage to minimize the transfer of any friction forces from items of clothing to the wound. Bogart fails to teach the method is for treating blister *per se*. However, since a blister is a type of wound, the examiner contends that the Bogart's method encompasses a blister.

As to claim 22, Bogart a method comprising the steps of placing a protective layer of a bandage against the area of skin that is to be protected; adhesively securing the bandage to the skin using a layer of pressure- sensitive adhesive that surrounds but does not touch the area of skin to be protected; placing a low-friction surface on a side of the bandage opposite the protective layer; and adhering a layer of low-friction material to the bandage between the low-friction surface on the bandage and items of clothing, the layer of low- friction material being movable with respect to the low-friction surface on the bandage to minimize the transfer of any frictional forces from clothing to the area of skin to be protected.

The applicant should note that the placement of the bandage of Bogart on the skin of a user inherently accomplishes applicant's claimed method.

As regards claim 23, Bogart discloses bandage for the skin comprising: a first layer (52) formed of a low-friction material, the first layer having an upper surface and a lower surface; a protective layer (74) disposed on the lower surface of the first layer; a layer of adhesive (72) surrounding the protective layer on the lower surface of the first layer; and a second layer of a low-friction material (60) being disposed adjacent and attached to the upper surface of the first layer in such a manner that the second layer moves with respect to the upper surface of the first layer in a direction generally parallel to the upper surface of the first layer in response to forces applied to the second layer (col. 3, lines 40-42, col. 4 lines 30-44 and col. 4, line 50-col. 5, line 2).

As regards claims 24 and 25, Bogart anticipates applicants' claim since the second layer is only attached to the upper surface of the first layer at selected locations, the selected locations being the entire upper surface, which include the corners.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bogart.

As regards claim 9, Bogart fails to teach discontinuous application of the dry adhesive recited in col. 4, lines 30-45. The examiner contends that it would have been *prima facie* obvious to one having ordinary skill in the art to discontinuously apply adhesive on the substrate for attachment to the film to reduce the cost of manufacturing the device.

As regards claim 10-13, Bogart discloses that the film layer has a static coefficient of friction of about 0.48, and that substrate layer has a static coefficient of friction of about 1.169.

Bogart fails to teach that the substrate layer has a coefficient of friction of less than 1.0. However, since the purpose of the device of Bogart is to allow the film layer

and the substrate layer to easily move with one another, the examiner contends that one having ordinary skill in the art would have found it within the level of ordinary skill in the art to select another stretchable layer for the substrate as an obvious design choice. The examiner further contends the device of Bogart would perform equally well with a layer having a coefficient of friction of less than 1.0.

Additionally, the applicant should note that the substrate and the film layer have a coefficient of friction less than skin.

Allowable Subject Matter

9. Claims 2-7 and 26-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. Claims 14-20 are allowed.

Conclusion


11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,362,387 discloses a self-adhering friction reducing liner having a low-coefficient of friction layer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is 703.308.1191. The examiner can normally be reached on Mondays to Thursdays from 5:30 am to 4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 703.308.0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kim M. Lewis
Primary Examiner
Art Unit 3743

Kml
September 19, 2004